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Our Case No. 11495/111
(LGG 0185 PUS)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Lea Antony Ashfield

Serial No. 10/674,852

Filing Date: September 29, 2003

For BATTERY OPERATED CHAIN
SAW

Examiner: Issac Hamilton

Group Art Unit No. 3724

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the final Office Action mailed June 2, 2006, Applicant has filed this Pre-Appeal Brief Request for Review, as well as the accompanying Notice of Appeal, within three months of mailing of the final Office Action. The most recent amendments to the claims in this application were filed an Amendment filed on March 1, 2006, and are already of record.

Claims 1-10 and 12-20 are pending in this application and have been finally rejected. Applicant wishes to avail himself of the expedited PTO procedure for appeals in

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accordance with the procedures designated in the USPTO's Official Gazette notice dated July 12, 2005.

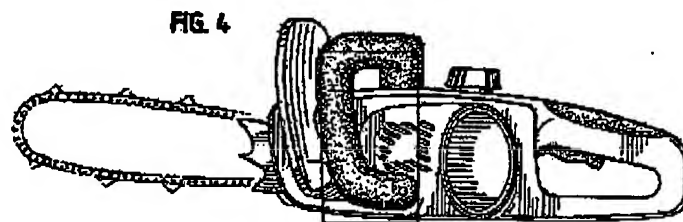
Claims 1, 4-6, 10, 14-16, and 20 are rejected under 35 U.S.C. § 102(b) as anticipated by US Design Patent No. D408,246 to Juratovac ("Juratovac"). Applicant respectfully traverses the rejection because Juratovac does not disclose all of the limitations of independent claims 1, 6, 10, and 20. The figures in Juratovac show two perspective views of the chain saw and a plan view of each side of the chain saw. The chain saw includes a chain bar, a front handle, a rear handle with a trigger, and a cap. FIGs. 1 and 4 show several oblique boxes that the Examiner has interpreted to be a vented housing for a motor. The Examiner additionally considered the oval member positioned rearward of the "vented housing" to be a removable battery.

Juratovac does not disclose all of the limitations of claim 1, which requires that the battery is located on the frame to provide a front-to-rear chain saw center-of-gravity located at least partially beneath or at least partially in front of the front handle. Specifically, Juratovac does not provide any indication where the center-of-gravity on the chain saw is located, let alone reasonably disclose to one of ordinary skill in the art that the center-of-gravity is either partially beneath or partially in front of the front handle.

A relevant dictionary definition of the term "center of gravity" is "1) center of mass 2) the point at which the entire weight of a body may be considered as concentrated so that if supported at this point the body would remain in equilibrium in any position." *Merriam-Webster's Collegiate Dictionary*, Eleventh Edition, p. 200, 2003. This definition is consistent with the use of the term in the as-filed specification. For example, the specification states that "[t]he disadvantage of having the power pack inserted behind the rear handle is that the center-of-gravity of the chain saw is behind the front handle. Thus, when kick back occurs during operation, the rearwardly located center-of-gravity will amplify the kick back action." As filed specification, paragraph [0005]. Juratovac does not disclose or suggest where the center-of-gravity of the chain saw shown in the figures is located, much less that the front to rear center-of-gravity is at least partially beneath the front handle or at least partially in front of the front handle.

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Even if, *arguendo*, one of ordinary skill in the art interprets the Juratovac chain saw to be constructed as specified by the Examiner, i.e. that the motor is enclosed within the vented housing and the battery is rearward of the vented housing (as best shown in FIGs. 1 and 4 of Juratovac), one of skill in the art would understand that the Juratovac center-of-gravity is behind the front handle and not the claimed at least partially beneath or at least partially in front of the front handle. Specifically, a relevant dictionary definition of the term "beneath" is "directly under; underneath." *Merriam- Webster's*, p. 113. Contrary to the notations made on Diagram 1 provided on page 3 of the Office Action dated June 2, 2006, the range of potential positions that are beneath the front handle are not along substantially the entire length of the chain saw. One of ordinary skill in the art would not consider many of these points included within the diagram to be remotely close to the region of potential locations of the claimed center-of-gravity. In contrast, the range of potential locations beneath the front handle are shown within the box inscribed on FIG. 4 of Juratovac, below.



The two components that normally have the largest mass in a battery powered chain saw are the motor and the battery. These components generally have the largest impact on the location of the center-of-gravity of the chain saw. As interpreted by the Examiner, the Juratovac battery is completely behind the front handle and a portion of the motor is also behind and spaced from the front handle. Accordingly, one of ordinary skill in the art would interpret the Juratovac center-of-gravity to be behind the front handle if they were forced to guess at the position of the center-of-gravity.

Further, while the center-of-gravity is likely at some location behind the front handle, the specific location is unknown and Juratovac cannot not rationally be considered to disclose the exact location of the center-of-gravity. Because Juratovac

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does not provide an enabling disclosure of all of the limitations of claim 1, by definition it cannot anticipate these claims. *Merck & Co. v. Teva Pharmaceutical USA, Inc.*, 347 F.3d 1367, 1372 (Fed. Cir. 2003). Because Juratovac does not disclose or suggest all of the limitations of claim 1, much less dependent claims 4-5, Applicant respectfully states that the rejection of these claims is in error and should be withdrawn.

The obviousness rejection of claims 2-3 over a combination of Juratovac and U.S. Patent No. 5,016,355 to Gassen ("Gassen") is erroneous. The rejection is improper because there is no motivation to combine these references. Even if these references could be properly combined Gassen does not cure the deficiencies of the use of Juratovac to reject independent claim 1 because Gassen discloses a chain saw with an internal combustion engine and not a battery. Accordingly, the combination of Juratovac and Gassen cannot reasonably teach the location of a center-of-gravity of a chain saw with a electric motor and a battery.

The rejection of claims 6 and 10 is in error. As discussed above, Juratovac is a design patent that does not provide any indication of the location of the center-of-gravity of the Juratovac chain saw, much less that the center-of-gravity is "proximate the front handle." A relevant dictionary definition of "proximate" is "very near: close." *Merriam-Webster's*, p. 1002. The specification uses the term consistently with this definition. Juratovac does not provide an enabling disclosure of the location of the center-of-gravity of the Juratovac chain saw. *Merck*, 347 F.3d at 1372. While one of ordinary skill in the art would appreciate that the center-of-gravity is by definition at some point on the chain saw, Juratovac does not disclose or suggest that the center-of-gravity is very near or proximate the front handle. Claims 7-8 and 12-18 are rejected as obvious over a combination of Juratovac and Gassen. As discussed above, Gassen discloses a completely different type of chain saw with an internal combustion engine and does not provide an enabling disclosure of the claimed limitations. Accordingly, the rejection of claims 6-8, 10, and 12-18 is in error and should be withdrawn.

Claims 9 and 19 are rejected under 35 U.S.C. § 103(a) as obvious over a combination of Juratovac in view of U.S. Patent No. 5,213,913 to Anthony, III ("Anthony"). Anthony and Juratovac were improperly combined because Juratovac

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does not disclose or suggest that the Juratovac battery is removable. Even if these references could be properly combined Anthony does not cure the deficiencies of the use of Juratovac to reject independent claims 6 and 10 because Anthony provides no disclosure of the structural designs of chain saws, much less the potential location of a center-of-gravity of a battery powered chain saw. Accordingly, the combination of Juratovac and Anthony does not disclose or suggest all of the limitations of claims 9 and 19. The Examiner's rejection is in error and should be withdrawn.

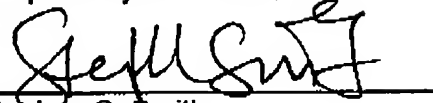
Claim 20 is rejected as anticipated under 35 U.S.C. §102(b) by Juratovac. Claim 20 requires a power pack removeably connected to the frame proximate a lateral side of the frame and at least partially in front of the front handle. Juratovac does not disclose or suggest these features. Initially, Juratovac does not disclose that the battery pack is removable. There is no structure shown on Juratovac that would suggest to one of ordinary skill in the art that the battery is removable, assuming *arguendo* that the battery is the portion identified by the Examiner. Notably, there is no latch mechanism or similar structure shown in Juratovac that would retain the battery within the chain saw during operation. Additionally, as best shown in FIG. 4 of Juratovac, the "battery" identified by the Examiner is completely behind the front handle and not at least partially in front of the front handle as claimed. Neither Juratovac, nor the prior art of record, show a chain saw with a removable battery that is at least partially in front of the front handle. Accordingly, the Examiner's rejection of claim 20 was in error and should be withdrawn.

For at least the reasons identified and discussed above, Applicants respectfully traverse the rejections of independent claims 1, 6, 10, and 20. Dependent claims 2-5, 7-9, and 12-19 are patentable at least because the independent claims that they refer to are patentable.

The final Office Action dated June 2, 2006 fails to make out proper rejections for the claims of the application. The undersigned respectfully requests that the rejections in the present application be reversed and the application be advanced to allowance.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Stephen C. Smith", written over a horizontal line.

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